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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,678	08/01/2001	Ralf Wichmann	LE 00/032 (7244*111)	6224

23416 7590 07/31/2002

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EXAMINER
LE, HOA VAN

ART UNIT	PAPER NUMBER
1752	4

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/919,678	WICHMANN ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-36* is/are pending in the application.

4a) Of the above claim(s) *21-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-20 and 31-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *21-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

This application is before the examiner for consideration on the merits.

A. The specification has been amended. Applicants state on the record that there is no new matter being added in the amendment. If a new matter is found, please see the authority in Tronzo v. Biomet Inc., 41 USPQ2d 1403.

B. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. The groups of claims (16-19 and 31-36) and (20) (have not been considered to be patentably different or distinct. Therefore, no separate consideration or search made. Accordingly, no restriction is made. If applicants show or urge otherwise in the next response to this Office action in order for it to be considered timely. A restriction will be made for the record as shown or urged.), bleaching composition as clearly state and set forth for the record.), drawn to a bleaching composition, classified in class 430, subclass 460.

II. Claims 21-22, drawn to a process of preparing the composition, classified in class 430, subclass 450.

III. Claims 23-30, drawn a method of using the composition, classified in class 430, subclass 393.

The inventions of Groups II and Group III are related to methods but have the patentably different and distinct and have acquired the separate status and searches in the art and can be supported the separate patents and have no evidence of the record that are not required the

separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions of Group I and Groups (II and III) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for forming an image can be practiced with another materially different product such as using a separate sheet containing a silver halide complexing agent. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status in the art and can support the separate patents as divided by applicants and have no evidence of the record that they are not patentably different or distinct and are the obvious variants under 35 U.S.C. 103 to one having ordinary skill in the art since no separate consideration or search is necessitated or required because a prior art being applied against one invention is sufficient against all of them, restriction for examination purposes as indicated is proper.

However a process claim is permitted to be rejoined with an allowable material claim provided the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in In re Ochiai, 37 USPQ2d 1127 or In re Brouwer, 37 USPQ2d 1663 and MPEP 821.04. Accordingly, applicants are required to identify any process claim that contains all of the limitations the elected material claims for an examination in each of the response to an office action in order for it to be properly and timely rejoined as set forth.

During a telephone conversation with Ashley I. Pezzner on June 05, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims (16-19 and 31-36) and (20) . Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

C. Applicants' prior art submissions filed on December 18, 2001 and January 03 and 08, 2002 have been considered.

D. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-20 and 31-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers et al (5,389,501), Kuse et al (5,453,348), Ueda et al (5,580,705), Yamashita et al (5,635,341), Inaba et al (5,885,757) or Mc Guckin et al (6,022,674).

Patentee in each of the above references discloses, teaches, demonstrates and reduces to practice with a solution comprising a sufficient amount ferric salt of propylenediaminetetraacetic acid as a silver halide photographic bleaching agent. Please see the whole disclosure of each of the applied references, especially in Roger et al at cols.3 and 4 about the last 10 from the bottom under "Bleach", Kuse et al at Example 1, Experiments I(3, 4, 5, 10, 11, 12 and 13, Example 7 and Experiments 5(2-9), Ueda et al at Experiment Nos. 1-2, 2-2, 9(8-18), Yamashita et al at Experiment Nos. 1(1-5), 2(1-5), 3(1-5), 5(1-8), Inaba et al at Example1, Table 1 No. 102, Example 2, Table 2, No. 202, Example 5, Table 3, No.502 and Example 8, McGuckin et al at Examples 1, 3, 4 and 5. Any embodiment being not directly related to the requisite chemical ingredient in the main "solution" embodiment is considered as an intended use and would have and is given no value in the above applied statute under 35 USC 102 (but are given a full value in a process or method claim only as required). Since patentee in each of the above applied references discloses, teaches, demonstrates and reduces to practice with the solution containing the requisite chemical ingredient, the above claims are found to be anticipated by each of them.

E. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 16-20 and 31-36 rejected under 35 U.S.C. 103(a) as being unpatentable over Kuse et al (5,453,348), Ueda et al (5,580,705), Yamashita et al (5,635,341), Inaba et al (5,885,757), Nakamura et al (5,658,715), Kuramitsu et al (6,048,673) and/or Irie (6,346,368).

Patentee in each of the above references discloses, teaches, suggests, demonstrates and reduces to practice with a silver halide photographic bleaching solution comprising a sufficient amount ferric salt of propylenediaminetetraacetic acid as a silver halide photographic bleaching agent for use with a color reversal silver halide photographic material. Please see the whole disclosure of each of the applied references, especially in Kuse et al at Example 1, Experiment I(3, 4, 5, 10, 11, 12 and 13, Example 7 and Experiments 5(2-9), Ueda et al at Experiment 2, 2-2, 9(8-18), Yamashita et al at Experiment Nos. 1(1-5), 2(1-5), 3(1-5), 5(1-8), Inaba e Example1, Table 1 No. 102, Example 2, Table 2, No. 202, Example 5, Table 3, No.50 Example 8. Patentee also discloses, teaches, suggests, demonstrates and reduces to p the adjacent homologues. Please see Kuse et al at compound on col.103, line 49- in Experiments 1(11-13), 2(11-13) and 9(37-42), Yamashita et al in Experiment 25), 3(21-35) and 5(25-32). Inaba et al in Experiments Nos. 101, Kuramitsu et Ire at col.7:14 and Nakamura et al use either ferric salt of ethylenediaminet propylenediaminetetraacetic acid or both as the beaching agent on col.10: Any embodiment being not directly related to the requisite chemical ing "solution" embodiment, would have and is given as a secondary valu under 35 USC 103 (but are given a full value in a process or). No patentable value is given for the cla ims must be included both

using the solution with the specified and limited "silver halide material" as narrowly claimed only. Since patentee in each of the above applied references discloses, teaches, demonstrates and reduces to practice with the solution containing the requisite chemical ingredient or its adjacent homologue, the above claims are found to be rendered prima facie obvious by the applied references. The showings in the instant application have been considered but have and are given a little or limited value for a patentability of the claims as broadly disclosed with respected to munbers of the chemical and their amount in each of the tested solutions. It would like to see a result of a test using about 0.045 mol/l of a claimed beaching agent and the applied adjacent homologue as broadly claimed.

F. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7172 for regular communications and 703-746-7172 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
July 30, 2002

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le